The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 88

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MORRIS REESE

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Appeal No. 1999-1612
Application 08/614,188

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ON BRIEF

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Before KRASS, JERRY SMITH, and FLEMING, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

ON REQUEST FOR REHEARING

Appellant requests that we reconsider our decision dated February 28, 2001. In this decision we reversed the rejection of claim 54 under 35 U.S.C. § 103 over Blakley in view of Lottes et al. or Hattori and affirmed the rejection of claim

54 under 35 U.S.C. § 112, first paragraph, for failing to provide an adequate written description and enabling disclosure of the claimed invention. Appellant challenges our affirmation of the rejection of claim 54 under 35 U.S.C. § 112.

As noted by our reviewing court in ***Enzo v. Calgene***, 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135, we have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." **See, *e.g.*, *In re Wands***, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 ("Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation'.")(footnotes, citations, and internal quotation marks omitted). In ***Wands***, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation

necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. **Id**. at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. ***See Amgen, Inc. v. Chugai Pharm. Co., Ltd***., 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the ***Wands*** factors "are illustrative, not mandatory. What is relevant depends on the facts.").

Appellant traverses our findings that: (1) the specification is devoid of any working examples or guidance which would provide details needed for one of ordinary skill in the art to practice an invention directed to the specific feature claimed of transmitting caller identification information during a silent interval of a call waiting cycle and (2) the state of the prior art is such that the skilled

artisan cannot be charged with the knowledge thereof.[1]

On page 2 of the request for rehearing, Appellant challenges our findings on the state of the prior art. For the first time, Appellant presents Bellcore Communications Research Technical Reference TR-TSY-000031, Issue 1, dated June 1986 for consideration (hereinafter Bellcore '031, 1986)[2]. Appellant also directs attention to Bell Communications Research Technical Reference TR-TSY-000030, Issue 1, dated November 1988 (hereinafter Bellcore '030) originally made of record during prosecution. Appellant argues that recently discovered passages in the above references clearly provide details that would enable one skilled in the art to perform the step of "transmitting DN information to a busy called station after a call waiting tone is applied for an incoming call receiving call waiting treatment" as recited in claim 54. Appellant specifically directs our attention to page 1, section 1.1, second

[1]See page 14 of the decision dated February 28, 2001.

[2]Bell Communications Research Technical Reference TR-TSY-000031, Issue 2, dated June 1988 was made of record during prosecution.

paragraph, of Bellcore '030 and to page 1, section 1.3, second paragraph; page 3, section 3.1.1.2., first paragraph; page 11, section 3.8, first and second paragraphs; and page 14, section 3.10, first and second paragraphs, of Bellcore '031, 1986.

Bellcore '030 is "Bellcore's view of proposed generic requirements for SPCS Customer Premise Equipment Data Interface."[3] Section 1.1, page 1, acknowledges that while it is possible to send data when Customer Premise Equipment (CPE) is in an off-hook or an on-hook condition, "in an off-hook state, additional complexities arise regarding interrupting an existing voice conversation during data transmission." This section also notes that "[t]hese complexities are beyond the scope of this document, so the off-hook case is not addressed herein." We find that these passages do not provide any details which would show that the skilled artisan had necessary details needed on how to make and use an invention which requires transmission of caller identification data during an off-hook state. This passage, in fact, implies that

[3]See page iii of the reference.

there were complex problems with transmission of data on a busy line still existing as of 1988, but provide no evidence that a solution had been found.

We turn next to Bellcore '031, 1986 which represents "Bellcore's view of the generic requirements for CLASS Feature: Calling Number Delivery."[4] The above cited passages make clear that as of 1986, Bellcore viewed one requirement of Calling Number Delivery (CND) to be transmission of a calling party's DN to a called party with Call Waiting service while that called party was busy on another call. Section 3.8, Interactions, presents Bellcore's recommendation of how this would be accomplished. The alerting tone of the Call Waiting cycle would be used as an indication to the CPE of the called party that an incoming data message would follow. The calling party DN would then be transmitted during the silent interval after the alerting tone. However, this same section takes note of a problem with this procedure.

> "The standard Call Waiting tone . . . . which is machine readable (i.e., it could be detected by the CPE), may not be satisfactory for this purpose. However, because of its fairly short duration and because it consists of a

[4]See page ii of the reference.

> single frequency that is in a common portion of the voice band, the standard Call Waiting tone can probably be easily simulated by voice or noise. Therefore a CPE designed to disable its transmitter upon receipt of this tone might inadvertently deactivate the transmission path when handling normal speech."

The reader is then directed to TR-TSY-000030 for further details.[5] We find that Bellcore in this 1986 document recommended that caller identification data be transmitted to a busy called station during a silent interval of the call waiting cycle but also found a problem with technology existing at that time. The skilled artisan is not told how to modify the alerting

tone of standard call waiting so that voice or noise of normal speech would not be confused with it. Therefore, no solution to this problem is provided.

Bellcore's TR-TSY-000031, Issue 2, dated June 1988, replaced the 1986 version discussed above. Page 1, section 1.3, second paragraph; page 3, section 3.1.1.2., first

[5]The current version of TR-TSY-000030 on record is dated 1988 and thus could not be the document to which the 1986 version of TR-TSY-000031 refers the reader. The 1988 version of TR-TSY-000030 replaces a 1984 version of that document. However, the 1984 version is unavailable.

paragraph; page 11, section 3.8, first and second paragraphs; and page 14, section 3.10, first and second paragraphs, still exist in the 1988 version. However, these sections state unequivocally that "transmission of CND data from the terminating SPCS to the CPE should *never* take place while the CND customer is in an off-hook state [italics original]."[6] We find the 1988 version of TR-TSY-000031 evidence that the problems noted in the 1986 version of that document had not yet been solved.

In sum, we find the documents as a whole provide a view of features Bellcore desired to be a part of a Call Waiting service. However, these documents also detail a problem associated with implementing the particular feature of transmitting caller identification data to the busy line of called party and make clear that a solution to the problem had not been found. These documents then constitute little more than an invitation to try and find a solution to the problem.

[6]SPCS is an acronym for Stored Program Control System. Both the originating, or caller, and the terminating, or called party, Customer Premise Equipment (CPE) each have SPCS associated therewith.

On page 3 of the request for rehearing, Appellant challenges our findings on the failure to include working examples in his specification. He asserts that "every detail needed to practice the claimed invention need not be explained in the specification because 'what is general and conventional knowledge in the art is read into the specification'." However, as discussed above, the documents presented by Appellant provide no details on how to overcome the problem of transmitting caller identification to a caller with Call Waiting who is at that time engaged in another phone call. Thus, we find the knowledge needed to overcome this problem is not general or conventional and the details should have been included in the specification. It would therefore have required undue experimentation to make and use the invention. Thus, we find that the Examiner had a reasonable basis for questioning the adequacy of Appellant's disclosure.

In view of the foregoing, Appellant's request for reconsideration is denied as to making any change in our decision.

DENIED

ERROL A. KRASS Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
MICHAEL R. FLEMING Administrative Patent Judge	)

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